

Remarks

Applicants respectfully request reconsideration of the above-identified application. Claims 1, 4-6, 11, 14, 16-17, 19, 21-22, 27-29, 39-66 remain in this application. Claims 1, 4-6, 11, 14, 16-17, 19, 21-22, 27-29, 39-44 were withdrawn from consideration as directed to non-elected subject matter. Claims 2-3, 7-10, 12-13, 15, 18, 20, 23-26, and 30-38 were previously canceled. Applicants previously elected claims 45-66 for substantive examination.

I. Allowable Subject Matter.

Applicants note with appreciation the Examiner's statement that claims 46-47, 50-55, and 65-66 are directed to allowable subject matter.

II. Claim rejection under §112

Claims 45-66 were rejected under 35 U.S.C. §112, second paragraph as indefinite. Applicants respectfully traverse. Whether a claim recitation is indefinite "depends on whether one of skill in the art would understand what is claimed, in light of the specification." MPEP 2173.05(b).

The Office action states that "Claim 45 recites conveying a string of packaging cushions (all connected) to a primary path and an intermediate path." Applicants respectfully disagree with this summary; rather, claim 45 recites that at least one of the transport conveyor sections is adapted to be moveable between two positions. The first is the "conveyor-section open position" that establishes "an intermediate flow path for the string of packaging cushions." The second is a "conveyor-section closed position" that establishes "a primary flow path for the string of packaging cushions."

There is no requirement that the system convey the string of cushions through *both* the intermediate flow path and the primary flow path. The system works if it conveys the string of cushions through one or the other of the two paths.

Further, it is also unnecessary that claim 45 be required to recite a cutting or plunging device as suggested in the Office action, because, for example, the machine that is capable of manufacturing the string of packaging cushions could also manufacture several

independent strings of packaging cushions, for example, by intermittent manufacture of the strings.

Accordingly, Applicants respectfully submit that claim 45 is understandable to one of skill in the art in view of the specification and drawings.

III. Anticipation Rejection Based on Haley

Claims 45 and 48 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,078,255 to Haley. Applicants respectfully traverse this rejection. To anticipate a claim, an applied reference must teach each and every element of the claim. MPEP §2131.

Haley fails to teach or suggest “a machine capable of manufacturing a string of packaging cushions” as recited by independent claim 45. To the contrary, Haley teaches a “cookie oven.” (Col. 5, line 35.)

Further, Haley fails to teach or suggest a rotating member that is “adapted to cooperate with the transport conveyor to propel the string of packaging cushions . . . *between* the rotating member and the transport conveyor” as recited by independent claim 45. Although the previous Office action identifies item 21 as a rotating member, it is not a rotating member that cooperates with the transport conveyor to propel a string of packaging cushions *between* the rotating member and the transport conveyor. Rather, item 21 is merely a “surface conveyor” on which “cookies are transported.” (Col. 5, line 66 to col. 6, line 5.)

The rejected dependent claim 48 contains recitations in addition to those of the independent claim from which it depends, and is therefore further patentable over Haley.

IV. Anticipation Rejection Based on Marschke

Claims 45, 49, 56-61, and 64 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,732,609 to Marschke. Applicants respectfully traverse this rejection.

Marschke fails to teach or suggest “a machine capable of manufacturing a string of packaging cushions” as recited by independent claim 45. To the contrary, Marschke teaches a “double backer” device that adhesively joins component paper webs together to form corrugated paperboard. (Col. 2, lines 60-63.)

The rejected dependent claims contain recitations in addition to those of the independent claim from which they depend, and are therefore further patentable over Marschke. For example, Marschke fails to teach or suggest “at least one roll [that] comprises resilient foam” as recited in dependent claim 59.

V. Obviousness Rejection Based on Marschke

Claims 62-63 were rejected under 35 U.S.C. §103(a) as obvious in view of Marschke.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established to shift the burden of rebuttal to the Applicant. One of the requirements of a *prima facie* case of obviousness is that the applied prior art reference must teach or suggest *all* of the claim limitations. MPEP §706.02(j).

Dependent claims 62-63 ultimately depend from independent claim 45. A dependent claim incorporates all of the recitations of the independent claim from which it depends. At the least, a *prima facie* case of obviousness has not been established with respect to dependent claims 62-63 because Marschke fails to suggest all of the limitations of independent claim 45, as discussed above.

A further requirement of a *prima facie* case of obviousness is that the prior art must provide a suggestion or motivation for the proposed modification. MPEP 2143.01. The mere fact that a reference could be modified does not render the modification obvious.

The previous Office action states that it merely would have been a design choice as to how the elements of a device are arranged. However, this statement fails to identify a reason or motivation in the prior art as to why the inlet end of the Marschke transport conveyor would be placed at “an elevation higher than” the outlet elevation of the Marschke “double backer” device that produces the corrugated paperboard web.

Marschke fails to present a reason to elevate the Marschke corrugated paperboard web after it was manufactured. And there are at least two reasons *not* to elevate the Marschke corrugated paperboard web after it exits the double backer device. First, elevating the paperboard web would unnecessarily increase the expenditure of energy during the process.

Second, Marschke teaches that although “the corrugated paperboard web 10 has some inherent flexibility, it cannot be bent too severely without causing a permanent lateral crease or break in the web.” (Col. 4, lines 59-65.) In fact, Marschke teaches a gradual change in direction over a sufficiently large radius curve to lower the corrugated paperboard. (*Id.*) Therefore, it would not make sense to elevate the corrugated paperboard web, because doing so would not only risk creasing or breaking the paperboard on the rise, but also present the risk again when later lowering the paperboard back to the original elevation.

VI. Ownership Dispute

The undersigned attorney represents Sealed Air Corporation. There are four named inventors for this patent application. Two were employees of Sealed Air obligated to assign the inventions to Sealed Air at the time the inventions were made. Those two inventors have done so by formal assignment.

The other two inventors were employees of Kalow Technologies obligated to assign the inventions to Kalow at the time the inventions were made. One of the inventors has done so by formal assignment. However, the other named inventor, Michael Charney, has refused to execute a formal assignment to Kalow to document Kalow’s ownership of his interest. Michael Charney has stated that he retains ownership of his inventive contributions.

Kalow was also obligated by agreement to assign the inventions to Sealed Air at the time the inventions were made. Kalow has formally assigned the inventions to Sealed Air.

After reviewing the facts and applicable case law, it is Sealed Air’s position that Kalow (and therefore Sealed Air) owns Michael Charney’s interest in this patent application and his interest in the inventions, at least because Michael Charney was “employed to invent” by Kalow. Sealed Air believes that it owns Michael Charney’s interest regardless of whether he executes a formal assignment. Accordingly, Sealed Air believes that the subject matter of the pending claims were commonly owned (or subject to an obligation of assignment to the same entity) at the time the inventions were made.

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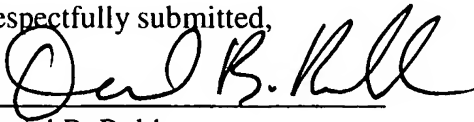
VII Conclusion

In view of these remarks, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

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Respectfully submitted,


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